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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/758,502	01/15/2004	David Benderly	BENDERLY	6160

156 7590 07/13/2007  
KIRSCHSTEIN, OTTINGER, ISRAEL  
& SCHIFFMILLER, P.C.  
489 FIFTH AVENUE  
NEW YORK, NY 10017

EXAMINER
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HEINRICH, SAMUEL M

ART UNIT	PAPER NUMBER
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1725

MAIL DATE	DELIVERY MODE
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07/13/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	Application No. 10/758,502	Applicant(s) BENDERLY, DAVID	
	Examiner Samuel M. Heinrich	Art Unit 1725	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 06 April 2007.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 38,39 and 41-43 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 38,39 and 41-43 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 38, 39, and 41-43 are rejected under 35 U.S.C. 112, first paragraph, because the steps of "filling the cutouts with a fusible material" and "sending the stencils from the manufacturing site to marking sites" and "adhering the stencils" is non-enabling. These three steps have been described in the specification, but have not been described in the sequence which is claimed. The instant Specification describes filling the stencil after the stencil has been affixed to the workpiece. The specification does not enable any person skilled in the art to which it pertains to perform the invention commensurate in scope with the instant claims.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 38, 39, and 41-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 6,129,965 to Langan in view of USPN 6,329,631 to Yueh and in view of USPN 5,760,367 to Rosenwasser and in view of JP358087846A and in view of JP356057037A.

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Langan describes (column 1, lines 36-47) well known label manufacture and label shipping and subsequent label use at a site separate from the manufacture site. Langan does not describe applying stencils and subsequent marking objects. Yueh describe (Front Page) a well known stencil filled with fusible material such as metal. The use of a stencil such as disclosed by Yueh with a manufacture and shipping technique such as described by Langan would have been obvious at the time applicant's invention was made to a person having ordinary skill in the art because the stencil can be produced at one site and used at a different site intended for a different production.

Rosenwasser et al describes (beginning at column 4, line 24) gemstone marking comprising the use of an absorptive coating applied to the gemstone surface.

With respect to combining the inscribing and fusing steps, see both JP358087846A and JP356057037A. JP358087846A describes (Abstract) the use of beam resist and direct exposure electron beam development and etching during manufacture of a semiconductor film. JP356057037A describes direct exposure patterning with a laser beam and resist film. The use of fusible material in a stencil with a gemstone at a manufacturing site would have been obvious at the time applicant's invention was made to a person having ordinary skill in the art because the stencil provides readily available and reproducible etching and coating with a marking material.

Claim 41 is rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 6,129,965 to Langan in view of USPN 6,329,631 to Yueh and in view of USPN

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5,760,367 to Rosenwasser and in view of JP358087846A and in view of JP356057037A as applied to claim 38 above, and further in view of USPN 4,179,322 to Brown et al.

Brown et al describes the use of a cover layer and the use thereof with a carrier a marking material would have been obvious at the time applicant's invention was made to a person having ordinary skill in the art because the cover protects the work piece prior to the use thereof.

Claims 42 and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 6,129,965 to Langan in view of USPN 6,329,631 to Yueh and in view of USPN 5,760,367 to Rosenwasser and in view of JP358087846A and in view of JP356057037A as applied to claim 38 above, and further in view of Applicant's Admitted Prior Art (AAPA).

AAPA describes (Specification, Description of the Related Art) related art which discloses well known application of marking material to diamonds including custom inscriptions and graphics. The use of a diamond workpiece with a marking process would have been obvious at the time applicant's invention was made to a person having ordinary skill in the art because marking of diamonds for identification has been done at least for decades.

### ***Response to Arguments***

Applicant's arguments filed April 06, 2007 have been fully considered but they are not persuasive. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642

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F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231

USPQ 375 (Fed. Cir. 1986).

### ***Conclusion***

Note, previously cited USPN 6,358,427 to Smith et al describe (Abstract) applying a plasma resist to the surface of the gemstone. GB2125340A describes an adhesive stencil guide.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

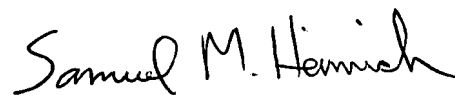
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Samuel M. Heinrich whose telephone number is 571-272-1175. The examiner can normally be reached on M-F.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, J. Johnson can be reached on 571-272-1292. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Samuel M Heinrich  
Primary Examiner  
Art Unit 1725

SMH